

### **REMARKS**

Reconsideration of this application is respectfully requested in view of the above amendments and the remarks contained herein.

#### **STATUS OF CLAIMS AND SUPPORT FOR AMENDMENTS**

Upon entry of this amendment, claims 1-4 and 8-22 will be pending in this application. Claims 5-7 have been cancelled without prejudice to, or disclaimer of, their subject matter.

Support for the amendments to claims 1-4 can be found in the specification at paragraphs [0050] to [0055] and [0064] to [0084], and in Figures 2-6.

#### **INDEFINITENESS REJECTION**

On pages 3-4 of the Office action dated January 5, 2010 the Office has rejected claims 1-21 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicants respectfully traverse this rejection for the reasons given below.

The Office states:

The phrases "small and large amount of information" render the independent claims indefinite. How does the system know that color data is a large amount of data versus black and white data being a small amount of data? A page with a sentence in color can be considered as a small amount of data compared to a ten page document with black and white text and graphics covering each and every sheet of paper. Claims 2-7, 9-14 and 16-21 are rejected based on their dependency.

Office action dated January 5, 2010 at pages 3-4.

First, Applicants submit that this rejection is moot with respect to claims 1-4, as the terminology to which the Office objects is no longer present therein.

Second, with respect to claims 8-21, Applicants submit that those having ordinary skill in this art can readily determine whether a particular set of data being processed is large or small. The Office will note that its own guidelines state that:

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph.

MPEP § 2173.05(b). Applicants submit that those having ordinary skill in this art, and reading Applicants' specification, would be readily able to determine whether a particular method or apparatus treats data containing large amounts of information differently from data containing small amounts of information, as recited in the claims. Accordingly, such a worker could determine whether such a method or device falls within the scope of the claims under 35 U.S.C. § 112, second paragraph. See *In re Johnson*, 194 USPQ 187 (CCPA 1977); See *In re Miller*, 441 F. 2d 689, 169 USPQ 597 (CCPA 1971).

#### OBVIOUSNESS REJECTIONS

A. Claims 1-5, 7-12, 14-19 and 21 over Moro in view of So et al., Mishima and Chiarabini et al.

On pages 4-49 of the Office action dated January 5, 2010, the Office has rejected claims 1-5, 7-12, 14-19 and 21 under 35 U.S.C. § 103(a) as obvious over U.S. Patent Publication No. 2004/0095605 (Moro) in view of U.S. Patent No. 6,628,419 (So et al.), U.S. Patent No. 6,381,031 (Mishima) and U.S. Patent No. 7,324,228 (Chiarabini et al.). Applicants respectfully traverse this rejection for the reasons given below.

Applicants respectfully submit that Moro does not teach or suggest a combination of discrimination of a print job to determine whether plural prints are to

be made, discrimination of image data to determine whether it is monochrome or color data, and the controlling of processing mode to allot compressing/expanding devices based upon the result of these discrimination operations. Moreover, none of the other cited references (So et al., Mishima, or Chiarabini et al.) cure this deficiency in Moro. Accordingly, even if the references were combined in the manner suggested by the Office, the result would not be Applicants' claimed invention.

For these reasons, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness, and that this rejection should be withdrawn.

B. Claims 6, 13 and 20 over Moro in view of So et al., Mishma and Chiarabini et al., and further in view of Shiohara

On pages 49-53 of the Office action dated January 5, 2010, the Office has rejected claims 6, 13 and 20 under 35 U.S.C. § 103(a) as obvious over Moro in view of So et al., Mishima and Chiarabini et al., as applied to claims 1, 8, and 15 above, and further in view of U.S. Patent Application Publication No. 2003/0122935 (Shiohara). Applicants respectfully traverse this rejection for the reasons given below.

Shiohara does not cure the deficiencies of Moro, So et al., Mishima, and Chiarabini et al. noted above. Accordingly, even if it were proper to combine Shiohara with the other cited references, the claimed invention would not be obtained.

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For these reasons, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness, and that this rejection should be withdrawn.

#### CONCLUSION

Applicants submit that this application is in condition for immediate allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions about this application, or believes that any issues remain to be resolved, the Examiner is respectfully requested to contact the undersigned to arrange for a personal or telephonic interview to resolve these issues prior to the issuance of another Office action.


The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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